

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR SHAO, RUSHAN JIANG, and MICHAEL MCGEE

Appeal 2006-2768
Application 09/729,810
Technology Center 2100

Decided: March 27, 2007

Before KENNETH W. HAIRSTON, JAY P. LUCAS, and ST JOHN
COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3-13, 15, 20, 21, 23-33, 35, and 40-42. Claims 2, 14, 16-19, 22, 34, and 36-39 have been canceled.

THE INVENTION

The disclosed invention relates to a mechanism for sharing information across a plurality of content services provided over a wireless connection to a mobile device. According to one aspect of the disclosed invention, data that was previously used or accessed through a mobile device is stored as data records at a location *external* to the mobile device. Metadata is also stored to *associate* the data records that contain data previously used by a particular mobile device with *that particular mobile device*. When service from a content provider is requested that requires input data through the mobile device, the user may, in lieu of manual entry, *select from a list of data items*, where the data items in the list *are retrieved from the data records associated with the mobile device*. Preferably, the list includes only those data items from the data records that correspond to the *type* of input data required by the service. In one embodiment, *the user manually specifies which data is to be pre-stored in the data records*. In another embodiment, the data records are generated and stored *dynamically in response to interaction with the mobile device*. By storing data received from some content providers and presenting it as an option to a user upon initiating a request for service from other content providers, the need by the user to manually enter the same input data repeatedly through a mobile device is eliminated. Additionally, information retrieved from one content service is made available to another content service, thus further reducing manual entry. By reducing the number of manual entries, the disclosed invention is thus directed to increasing the

accessibility and usability of content services that are accessed from mobile devices, such as web-enabled cell phones (Specification 3).

Representative claim 1 is illustrative:

1. A method for reducing user input required to access a plurality of services provided to a device, comprising:

storing, external to said device and separate from a first service of the plurality of services, data records containing a plurality of data items associated with a particular type of information,

wherein the step of storing said data records comprises:

receiving content, provided by one or more services, in response to being requested by the device;

parsing the content in an attempt to identify one or more data items associated with said particular type of information;
and

when the one or more data items are identified,
generating one or more data records that contain said one or more data items;

receiving a first message from said device requesting said first service, wherein said first service requires said particular type of information for input;

reading said data records and transmitting data to said device to cause said device to present a user interface allowing a particular data item of said plurality of data items to be selected;

receiving a second message indicating a selection from said device of said particular data item; and

Appeal 2006-2768
Application 09/729,810

sending said particular data item to said first service of said plurality of services.

THE REFERENCES

The Examiner relies upon the following references as evidence of anticipation and unpatentability:

Young	US 2002/0065774 A1	May 30, 2002 (filed Nov. 30, 2000)
-------	--------------------	---------------------------------------

David A. Patterson et al., *Computer Organization and Design: The Hardware/Software Interface*, 2d. ed., Morgan Kaufmann Publishers, Inc., 575-576 (1998).

THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1, 3-4, 9-13, 15, 20, 21, 23, 24, 29-33, 35, and 40-42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Young.
2. Claims 5-8 and 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Young in view of Patterson.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for the respective details thereof.

OPINION

Only those arguments actually made by Appellants have been considered in this decision. It is our view, after consideration of the record

before us, that the evidence relied upon supports the Examiner's rejection of the claims on appeal. Accordingly, we affirm.

Claims 1 and 21

We consider first the Examiner's rejection of independent claims 1 and 21 as being anticipated by Young.

Appellants argue the Examiner's reading of the claimed step of *storing* (i.e., "storing, external to said device *and* separate from a first service of the plurality of services") on the Young reference fails for at least the following reasons:

1. Young is silent with respect to how the product database is populated at the transaction portal server (Br. 5, 7).
2. Nothing in the cited portion of Young discusses *parsing* any content provided by a service, in an attempt to identify one or more data items associated with a particular type of information (Br. 8).
3. Young allegedly fails to disclose: "when the one or more data items are identified, *generating one or more data records that contain said one or more data items*," as recited by the language of claim 1 (Br. 10, emphasis added).

The Examiner disagrees. The Examiner asserts that the claimed step of storing reads on Young's disclosure of storing to "electronic wallet 17" that is external to "mobile phone 10" and separate from "merchant 20" (Answer 13, *see also* Young, Fig. 1). The Examiner asserts that identifying

one or more data items at “portal 15” involves parsing. The Examiner further asserts that “portal 15” generates transaction records including user purchase options and associated shopping information (Answer 14-15).

In the Reply Brief, Appellants further argue that Young fails to anticipate the claim because Young discloses the information stored in “electronic wallet 17” is entered by the *user*, and is not provided by a *service* (Reply Br. 3).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

In the instant case, we agree with the Examiner that the recited step of “storing” broadly but reasonably reads on Young’s disclosure of “user 5” storing payment (i.e., credit card) information, shipping information, and other personal information in “electronic wallet 17” where the wallet is external to “mobile phone 10” and separate from “merchant 20” (*see* Young,

Fig. 1, ¶ 0057).¹ In particular, we note the broad language of the claim does not specify exactly *what entity* “receiv[es] content, provided by one or more services,” as part of the recited “step of storing said data records” (claim 1). Therefore, we find Appellants’ argument misplaced that Young cannot anticipate the claim because the payment and shipping data stored in “electronic wallet 17” is *entered by the user* (see Reply Br. 3, *also see* Young ¶ 0057). We agree with the Examiner that “portal 15” receives product information in the course of an electronic wallet transaction. We find that Young’s “portal 15” retrieves product information from the database and then sends the product data to the mobile telephone via the mobile network (¶¶ 0053-0054). We note that Young explicitly discloses the user’s *shopping* and *payment* information is stored in the electronic wallet (¶ 0024, l. 3). Likewise, we agree with the Examiner that the product information (i.e., “content”) received by “portal 15” is inherently parsed and broken into smaller chunks as necessary for processing. Finally, we agree with the Examiner that “portal 15” also “generates one or more data records,” as claimed (see e.g., “The portal 15 also transmits order information to the merchant 20” ¶ 0061). Therefore, we find the Examiner’s rejection of claim 1 as being anticipated by Young is supported by the preponderance of the evidence.

Nevertheless, we also find an alternative reading of the claim on the Young reference. We find the step of “storing, external to said device and separate from a first service of the plurality of services, data records

¹ Young discloses “electronic wallet 17” is located on the transactional portal server in a preferred embodiment (¶ 0056, ll. 3-5).

containing a plurality of data items associated with a particular type of information” also reads on Young’s disclosure that “portal 15” transmits *payment authorization data* (i.e., including electronic wallet payment and shipping data) to “payment processor 18” (Young, ¶ 0060, ll. 3-4). In particular, we find the *payment authorization data* (i.e., “data record”) is at least temporarily *stored* when it is received by “payment processor 18” (*see* Young, ¶ 0060, ll. 12-13, i.e., “The payment processor 18 *receives the data* and provides authorization to the portal 15,” emphasis added). We note that “payment processor 18” is *external* to “mobile phone 10” and *separate* from “merchant 20” (*see* Young, Fig. 1, ¶¶ 0035-0036). Young discloses the *payment authorization data* (i.e., corresponding to the claimed “data records containing a plurality of data items associated with a particular type of information”) includes data obtained from “electronic wallet 17” as well as *purchase price and product identifier data*:

The payment authorization transmitted to the payment processor 18 includes data identifying the user (e.g., the name from the electronic wallet), data identifying the merchant from which the product is being purchased, and data relating to the product purchased (e.g., a *purchase price* and an *identifier*).

(¶ 0060, emphasis added).

In particular, we find the additional data relating to the product being purchased (i.e., the purchase price and the product identifier) corresponds to the claimed “*content, provided by one or more services,*” that is received in response to being requested by the device (claim 1, emphasis added).

We note again that the broad language of the claim does not specify exactly *what entity* “receiv[es] content, provided by one or more services,” as part of the recited step of “storing said data records” (claim 1). We further find the recited step of “storing said data records” broadly but reasonably reads on Young as follows:

receiving content, provided by one or more services, in response to being requested by the device;	Young discloses the “mobile phone 10” <i>device</i> makes a <i>request</i> when “user 5” elects to use (previously entered) payment data from the displayed wallet to perform a transaction (Fig. 1, ¶ 0058). The wallet data is received by “portal 15” in combination with <i>additional data relating to the product to be purchased</i> (e.g., a <i>purchase price</i> and a <i>product identifier</i>) that corresponds to the claimed “receiving <i>content, provided by one or more services</i> , in response to being requested by the device” (claim 1, emphasis added, <i>see</i> Young ¶ 0060).
parsing the content in an attempt to identify one or more data items	“Portal 15” receives payment and shipping data “content” that is

<p>associated with said particular type of information; and</p>	<p>inherently parsed, i.e., the electronic wallet data is broken into smaller chunks for processing whereby the payment and shipping data are inherently (i.e., necessarily) identified by type (§ 0060). Likewise, “Portal 15” communicates with merchant check-out software (§ 0036) that provides purchase interaction (i.e., including product identifier and price information obtained from the merchant web site) where the product information is also inherently parsed and broken into smaller chunks for processing and the product identifier and price information are distinguished (i.e., identified) by type (§§ 0035, 0036, 0060).</p>
<p>when the one or more data items are identified, generating one or more data records that contain said one or more data items;</p>	<p>“The portal 15 also transmits (i.e., generates) order information (i.e., data records) to the merchant 20” (§ 0061). Young discloses the order information (i.e., data records) includes purchaser identification,</p>

	product identification, shipping data, and payment data (§ 0061).
--	--

Because we find Young discloses all that is claimed, we will sustain the Examiner's rejection of representative claim 1 as being anticipated by Young. We note that claim 21 recites equivalent limitations to claim 1. Therefore, we will sustain the Examiner's rejection of claim 21 as being anticipated by Young for the same reasons discussed *supra* with respect to claim 1.

Claims 4, 9-13, 15, 20, 24, 29-33, 35, and 40

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 4, 9-13, 15, 20, 24, 29-33, 35, and 40. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's rejection of these claims as being anticipated by Young for the same reasons discussed *supra* with respect to independent claims 1 and 21.

Claims 3 and 23

We consider next the Examiner's rejection of claims 3 and 23 as being anticipated by Young.

Appellants argue the limitations of claims 3 and 23 are not anticipated by Young because Young fails to disclose the step of storing the data records comprises: “receiving content, provided by one or more services, in response to being requested by the device” (Br. 11, ¶ 1, ll. 3-4).

In response, we note that Appellants are arguing a limitation recited in independent claims 1 and 21, from which claims 3 and 23 depend, respectively. Because we have fully addressed this point of argument in the discussion of claims 1 and 21, we will sustain the Examiner’s rejection of claims 3 and 23 as being anticipated by Young for the same reasons discussed *supra* with respect to claims 1 and 21.

Claims 41 and 42

We consider next the Examiner’s rejection of claims 41 and 42 as being anticipated by Young. Appellants note claims 41 and 42 each recite:

the step of storing data records containing a plurality of data items associated with a particular type of information includes storing a particular data record that contains one or more values previously provided to said device by a second service that is different from said first service; and

(Claims 41 and 42).

Appellants note the Examiner has found this element is shown by Young’s transaction portal server that stores both the user’s shopping and payment information (Young ¶ 0024). Appellants argue the Examiner has ignored the limitation of storing a particular data record that contains one or more values *previously provided to the device by a second service that is different from the first service* (Br. 11).

We note the Examiner has found “portal 15” serves as an Internet portal to Internet content providers for mobile phone users associated with “wireless gateway 12.” The Examiner has further found “portal 15” stores the user’s shopping and payment information for content provided from at least some of the content providers including information such as news, offers for the purchase of goods and services, advertising, pictures, graphics, video communications and e-commerce offers. The Examiner points to Young at paragraphs 0024, 0061, and 0067 as providing support for this rejection (Answer 10).

After carefully considering the evidence before us, we find that the language of the claim broadly but reasonably reads on Young’s disclosure of authorization information (i.e., from the issuer, or first service) and also product identification information (i.e., from the merchant, or second service) (§ 0061). Therefore, we will sustain the Examiner’s rejection of claims 41 and 42 as being anticipated by Young.

Claims 5 and 25

Lastly, we consider the Examiner’s rejection of claims 5 and 25 as being unpatentable over Young in view of Patterson.

Appellants argue that the portion of Patterson cited by the Examiner lacks any teaching or suggestion of a predetermined threshold for an amount of data records, which when reached, causes the deletion of existing data records. Instead, Appellants assert the cited portion of Patterson discusses an approach for determining which items in a cache to replace once a decision to replace those items has been made. Appellants conclude that

nothing in the cited portion of Patterson discusses deleting existing data records in response to storing the one or more data records when an amount associated with the data records reaches a predetermined threshold, as claimed (Br. 12).

The Examiner disagrees. The Examiner asserts that a broad but reasonable interpretation of the claimed “predetermined threshold” reads on Patterson’s implementation of a least-recently-used (LRU) algorithm as applied to various types and levels of caches where, e.g., the data selected to be replaced (i.e., deleted) is the data that has gone unused for the longest time (Answer 16).

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In the instant case, we agree with the Examiner that Patterson’s system of selecting which cache blocks to replace according to certain predefined criteria (i.e., “predetermined thresholds” such as cache miss penalties) reasonably suggests the language of the claim. Thus, we conclude the Examiner has met the required burden of presenting a *prima facie* case of unpatentability. Accordingly, we will sustain the Examiner’s rejection of claims 5 and 25 as being unpatentable over Young in view of Patterson.

Claims 6-8 and 26-28

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 6-8 and 26-28. In the absence of a separate argument with respect to the

Appeal 2006-2768
Application 09/729,810

dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091. *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's rejection of these claims as being unpatentable over Young in view of Patterson for the same reasons discussed *supra* with respect to independent claims 1 and 21 and associated dependent claims 5 and 25.

DECISION

In summary, we have sustained the Examiner's rejection of all claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 3-13, 15, 20, 21, 23-33, 35, and 40-42 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2004).

AFFIRMED

rwk

HICKMAN PALERMO TRUONG & BECKER/ORACLE
2055 GATEWAY PLACE
SUITE 550
SAN JOSE CA 95110-1089